

REMARKS/ARGUMENTS

Claims 1-55 are pending in the present application.

This Amendment is in response to the non-final Office Action mailed October 9, 2009. In the Office Action, the Examiner rejected claims 35-37 under 35 U.S.C. §112; claims 1-40 under 35 U.S.C. §101; claims 25-33, 38-43, 46-48, 51, 53-55 under 35 U.S.C. §102; and claims 52, 1-24, and 34, 35-37, 44-45, and 49-50 under 35 U.S.C. §103(a). Applicant has amended claims 25, 33, and 35. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 35-37, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 35 to clarify the claim language.

Therefore, Applicant respectfully requests the rejection under 35 U.S.C. §112 be withdrawn.

Rejection Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 1-40 under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention, citing *In Re Bilski*, 88 USPQ2d 1385. In particular, the Examiner contends that claims 1 and 20, reciting a method comprising receiving metadata, are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent (Office Action, pages 4-5.) The Examiner further contends that the feature of “receiving metadata . . .” could be performed by a person/operator/distributor and the VOD server could be video rental store; the feature of “delivery ..” could be performed via mail (Office Action, pages 4-5, lines 1-4.) Applicant respectfully disagrees and submits that the Examiner’s interpretation of *Bilski* is misplaced.

A claimed process is statutory if it is limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33

F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19).

In its recently issued *en banc* majority opinion in *In re Bilski*, the U.S Court of Appeals for the Federal Circuit concludes that the "useful, concrete and tangible result" inquiry is inadequate and reaffirms that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply. *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008). Under the principles discussed in the *Bilski* decision, Applicant believes that claims 1-40 satisfy the machine-or-transformation test and are therefore statutory under 35 U.S.C. §101.

At the onset, the *Bilski* court emphatically states that "the proper inquiry under §101 is not whether the process claims recites sufficient 'physical steps,' but rather whether the claim meets the machine-or-transformation test." Accordingly, "a claim that purportedly lacks any 'physical steps' but is still tied to a machine or achieves an eligible transformation passes muster under §101." *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008). The *Bilski* court focuses the analysis under the principle articulated by the Supreme Court that whether the claim recites a fundamental principle and if so, whether it would pre-empt substantially all uses of that fundamental principle if allowed. *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972).

The *Bilski* court articulates the machine-or-transformation test as a two-branched inquiry. The *Bilski* court states that an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article, citing *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Applicant submits that claims 1-40 not only satisfy one but both tests as analyzed below.

1. Tying to a particular machine or apparatus:

In *Bilski*, the issues specific to the machine implementation part of the test are not before the court for review. The *Bilski* court therefore leaves to future cases the elaboration of the precise contours of machine implementation. However, there are a number of cases that have been decided by the court that provide clear guidelines in determining whether a claim is tied to a particular machine.

In *In re Abele*, when interpreting an earlier case, *In re Walter*, the court states that "Walter should be read as requiring no more than that the algorithm be 'applied in any manner to

physical elements or process steps,' provided that its application is circumscribed by more than a field of use limitation or non-essential post-solution activity. *In re Abele and Marshall*, 684 F.2d (CCPA 1982), 214 USPQ 682, 686 (CCPA 1982). The *Abele* court further states that if the claimed invention is an application of the algorithm, §101 will not bar the grant of a patent. *In re Abele*, 684 F.2d (CCPA 1982), 214 USPQ at 687 (CCPA 1982).

Accordingly, "tying to a particular machine" does not require that the process has to be performed by a machine, as the Examiner incorrectly suggests (Office Action, page 5, lines 1-4) ("the feature of 'receiving metadata ...' could be performed by a person/operator/distributor . . . the feature of 'delivery' could be performed via mail."). Rather, "tying to a particular machine" merely requires that the process *is applied to* a particular machine or apparatus, or a physical object.

An analysis of claim 1 shows that the process is applied a particular apparatus, satisfying the "tying to a particular apparatus" inquiry.

The first element of the claim recites "receiving metadata associated with a multimedia asset data file provided by at least one of a content provider and a multiple service or systems operator ("MSO"), the multimedia asset data file having a content element with which the metadata is associated and being delivered to end users upon requested, the metadata related to at least accuracy of delivery of the multimedia asset data file." This element involves "metadata," "a multimedia asset data file," "a content element," "a content provider," and "a multiple service or systems operator." All of these elements are physical entities and represent a particular apparatus.

Metadata are structured data which describe the characteristics of a resource. Metadata is structured information that describes, explains, locates, or otherwise makes it easier to retrieve, use, or manage an information resource. Metadata is often called data about data or information about information. The following links are examples of metadata:

<http://www.library.uq.edu.au/iad/ctmeta4.html>

<http://www.niso.org/publications/press/UnderstandingMetadata.pdf>

Accordingly, metadata are not abstract idea. They represent physical entities such as records stored in memory devices, which are related to a particular machine or apparatus.

A multimedia asset data file is a physical entity. It is an electronic or electromagnetic

record of a multimedia content. It is a tangible medium. It is not an abstract idea like democracy or freedom. Accordingly, it is tied to a particular apparatus or a machine. In addition, it is provided by a content provider or a multiple service or systems operator, which is also a physical entity.

Therefore, the first element of the claims involves physical objects that are tied to a particular machine or apparatus.

The second element of the claim recites “validating the multimedia asset data file and the associated metadata by determining if the multimedia asset data file and the associated metadata comply with business rules provided by the MSO.”

Again the second element involves the multimedia asset data file and therefore it is also tied to a particular machine or apparatus.

The third element of the claim recites “coordinating delivering the multimedia asset data file and associated metadata to a video-on-demand (“VOD”) server maintained by the MSO, wherein coordinating delivering comprises tracking distributing the multimedia asset data file from the content provider to the MSO, and tracking uploading the multimedia asset data file from the MSO to the VOD server; and providing usage reports relating to usage of multimedia asset data files by end users of the MSO.”

The third element clearly ties to a particular machine or apparatus. The element recites delivering .. to a video-on-demand (“VOD”) server. A VOD server is clearly a particular machine or apparatus. The delivering of the multimedia asset data file and associated metadata to a VOD server is clearly “tied to a particular machine or apparatus.” In addition, “usage reports” are physical entities and therefore they are also tied to a particular machine and apparatus.

Therefore, the third element of the claim is also tied to a particular machine or apparatus.

In summary, since all the elements of the claim apply process operations on multimedia asset data file and metadata through delivering to a VOD server, which is a particular apparatus, they are all tied to a particular machine or apparatus.

2. Transformation of an article:

In addition to tying to a particular machine or apparatus, the rejected claims also transform an article.

The claimed process receives metadata associated with a multimedia asset data file provided by at least one of a content provider and a multiple service or systems operator, validates the multimedia asset data file and the associated metadata, and coordinates delivering the multimedia asset data file and associated metadata to a video-on-demand (“VOD”) server. In other words, the claim transforms the location of a multimedia asset data file from the content provider or the MSO, transforms a non-validated multimedia asset data file and the associated metadata to validated multimedia asset data file and the associated metadata, and transforms the location of the validated multimedia asset data file and the associated metadata to a VOD server. Accordingly, the claim, among other things, transforms the multimedia asset data file and the associated metadata from one location to another location.

The *Bilski* court is very clear about what it means by “article” in transforming an article. The *Bilski* court states that “[s]o long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.” *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008).

In discussing *Abele*, the *Bilski* court states that “the claim was not required to involve any transformation of the underlying physical object that the data represented.” *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008). In other words, as long as a data represents a physical object, transformation of this data is sufficient to satisfy the transformation test. In *Abele*, the data represents the X-ray attenuation data produced in a two-dimensional field by a computed tomography scanner. The *Bilski* court states that this data clearly represents physical and tangible objects, namely the structure of bones, organs, and other body tissues. Here, the process operations operate on data representing physical objects. The multimedia asset data file is clearly a tangible object. The associated metadata represent the data record, a physical object. The VOD server is a physical object. Since these elements are all physical objects, the claim therefore transforms the data representing physical objects.

Similarly, independent claims 20 and 25 recite “multimedia asset data files,” “content elements,” “VOD sever,” “asset locator,” “content provider,” “MSO,” (claim 20); and “content,” “metadata,” “a server,” “end user,” “content provider,” “MSO”. These elements are all physical

elements, representing physical objects and are tied to a particular machine or apparatus (e.g., VOD sever, server). The process operations also transform the multimedia asset data file, the content by coordinating the upload of the content and tracking the upload, ingesting the content, coordinating the distribution and uploading of the content and the metadata.

In summary, the rejected claims satisfy not only one, but both the machine and transformation tests as articulated by the Supreme Court and the Court of Appeals for the Federal Circuit. Furthermore, the scope of the claim in the principles of performance simulation is such that there is no danger that it would wholly pre-empt all uses of the principle.

Accordingly, Applicant submits that claims 1-40 are statutory under 35 U.S.C. §101 and respectfully requests the rejections be withdrawn.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 25-33, 38-43, 46-48, 51, 53-55 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0143565 issued to Headings et al. ("Headings"). Applicant acknowledges the Examiner's note regarding US 2009/0144154 ("Schein"), US 2002/0143782A1 ("H782"), US 2009/0138925A1 ("H925"), US 2002/0083006A1 ("H006"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a prima facie case of anticipation.

Headings discloses a digital entertainment service. A Digital Content Services function of DESP 100 generally includes receiving and archiving media assets from a content supplier (Headings, paragraph [0027], lines 1-3; Fig. 1.) A digital service platform deposits its media assets, manages its media assets using business rules to control the distribution of and revenue generated from the media assets, and tracks consumer usage of its media assets to assist in consumer marketing decisions (Headings, paragraph [0008], lines 1-5.) Consumers access content in an aggregated manner similar to that of a traditional brick and mortar store (Headings, paragraph [0008], lines 12-14.) A consumer selects and orders the media content desired (Headings, paragraph [0055], lines 1-2; Fig. 2, step 208.) After a billing procedure, the consumer-requested content is electronically delivered to the consumer (Headings, paragraph [0064], lines 1-2; Fig. 2, steps 214 – 216.) Media assets, business rules, and related metadata, are bundled to create an "item" and ultimately distributed by the content user as providing unique

identification and naming (Headings, paragraph [0035], lines 1-5.) Items are classified and grouped into genres and channels commonly known by the content user (Headings, paragraph [0035], lines 8-11.) Metadata may include such descriptive information like copyright information, titles, authors, and abstracts (Headings, paragraph [0033], lines 5-6.) Intelligent media may include license tracking information (Headings, paragraph [0033], lines 12-13.)

Headings does not disclose, either expressly or inherently, at least one of: (1) ingesting content and metadata associated with the content provided by a content provider; (2) coordinating distribution of the metadata and the content, the distribution using a pitcher and a catcher, the pitcher transferring the content to a multiple service or systems operator (MSO) and the catcher receiving the content; and (3) coordinating uploading the metadata and the content to a server for delivery to an end user according to scheduling and business rules provided by the MSO; as recited in claim 25; or (1) an external layer to interface to an application client; (2) a component programmatic application program interface (API) coupled to the external layer to interface to a plurality of engines comprising: (2a) a workflow engine to manage workflows of ingesting a content and metadata associated with the content provided by a content provider, (2b) coordinating distribution of the metadata and the content, and coordinating uploading the metadata and the content to a server for delivery to an end user according to scheduling and business rules provided by a multiple service or systems operator (MSO); and (3) a relational database to store the metadata, as recited in claims 41 and 46.

Headings merely discloses a digital service platform controls the distribution of the media assets (Headings, paragraph [0008], lines 1-5.), NOT coordinating distribution of the metadata and the content, the distribution using a pitcher and a catcher, the pitcher transferring the content to a multiple service or systems operator (MSO) and the catcher receiving the content. A Digital Content Services function of DESP 100 merely receives and archives media assets from a content supplier (Headings, paragraph [0027], lines 1-3; Fig. 1.). There is no pitcher to transfer the content to the MSO and there is no catcher to receive the content. To clarify this aspect of the invention, claim 25 has been amended.

In addition, Headings merely discloses the content to be electronically delivered to the consumer upon consumer's ordering, NOT coordinating uploading the metadata and the content to a server for delivery to an end user according to scheduling and business rules provided by the

MSO. A consumer selects and orders the media content desired (Headings, paragraph [0055], lines 1-2; Fig. 2, step 208.) After a billing procedure, the consumer-requested content is electronically delivered to the consumer (Headings, paragraph [0064], lines 1-2; Fig. 2, steps 214 – 216.) Therefore, the delivery is not according to scheduling and business rules provided by the MSO. Since the system emulates a brick and mortar store that allows the consumers to browse and purchase content choices (Headings, paragraph [0003], lines 7-9; paragraph [0004], lines 3-4.), it cannot upload the content for delivery to an end user according to a schedule provided by the MSO. The system in Headings is designed for a consumer to select a content to purchase as if he or she walks into a video store. In contrast, the claimed invention recites operations that coordinate the delivery of the content to the end user according to a schedule provided by the MSO.

In rejecting claims 28, the Examiner contends that Headings discloses assigning a global identifier (Office Action, page 7.) Applicant respectfully disagrees. H782 merely discloses creating a unique identifier or internal title used to track the item data structure for further use (H782, paragraph [0032], lines 3-4.), NOT assigning a globally unique identifier to the content based on the provider identifier and a provider asset identifier. There is no evidence that the unique identifier mentioned in H782 is based on the provider identifier and a provider asset identifier.

In rejecting claim 29, the Examiner contends that Headings discloses validating the metadata and the content using the business rules, citing several paragraphs. Applicant respectfully disagrees. Headings merely discloses content suppliers can submit a media asset and associated business rules into a safe and secure platform depository (Headings, paragraph [0012], lines 1-4.), NOT validating the content and metadata using the business rules. Depositing the media asset and the business rules merely stores them in a safe depository. It does not validate the media asset. Headings explicitly states that the Digital Content Services function preferably includes use of a software-based application for creating and storing business rules 104, which govern how a particular media asset 102 is to be used (Headings, paragraph [0028], lines 1-4.) In other words, the business rules are used only to guide the use of the media asset 102. They are not used to validate the media asset 102. None of the cited paragraph discloses or suggests validating the content and the metadata using the business rules. Applicant respectfully requests

the Examiner to specifically point out the specific lines in the cited paragraphs that disclose this aspect of the claim.

In rejecting claim 33, the Examiner contends that Headings discloses a pitcher and a catcher (Office Action, pages 8-9.) Applicant respectfully disagrees. A pitcher or a catcher is an explicit appliance that is designed to transfer the content and to receive the content. A mere act of receiving a content does not mean that it is done using a catcher.

To anticipate a claim, the reference must teach every element of a claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). The Examiner bears the burden of presenting at least a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Only if that burden is met, does the burden of going forward shift to the applicant. *In re King*, 801 F.2d at 1327, 231 USPQ at 138-139; *In re Wilder*, 429 F.2d at 450, 166 USPQ at 548. Once a prima facie case is established and rebuttal evidence is submitted, the ultimate question becomes whether, based on the totality of the record, the Examiner carried his burden of proof by a preponderance. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the Examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Since the Examiner failed to show that Headings teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 25, 41 and 46 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(e) be withdrawn.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim 52 under 35 U.S.C. §103(a) as being unpatentable over Headings in view of U.S. Publication No. 2002/0104093 issued to Buehl et al.

("Buehl"); claims 1-24, and 34 under 35 U.S.C. §103(a) as being unpatentable over Headings in view of U.S. Publication No. 2002/0078174 issued to Sim et al. ("Sim"); and claims 35-37, 44-45, and 49-50 under 35 U.S.C. §103(a) as being unpatentable over Headings in view of U.S. Publication No. 2003/0020744A1 issued to Ellis et al. ("Ellis"). Applicant acknowledges the Examiner's note regarding US 2003/0149988 ("E988"), and US 2005/0149964 ("Thomas"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006). Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *MPEP* 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an explicit analysis for this reason must be made. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR* 127 S.Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant

differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

1. Claim 52:

Headings is discussed above.

Buehl discloses systems and methods for packaging, distributing and managing assets in digital cable systems. Cable television systems now receive broadcasts and retransmit them with other programming to users over land-line networks, typically comprising fiber optic cable and coaxial cable (Buehl, paragraph [0003], lines 2-5.) The content/service providers 15 could represent an Internet Service Provider (ISP) providing data to the system to enable subscribers web access or web-enhanced video via the subscriber's television set (Buehl, paragraph [0026], lines 15-18.) The content/service provider 15 transmits the content to a headend 30 via a high speed distribution network 25 for further transmission to subscribers downstream in the network (Buehl, paragraph [0026], lines 18-21.) The high speed distribution network 25 includes one or more satellite and/or fiber optic components and links for high-speed data transmission of content and/or services to the headend 30 (Buehl, paragraph [0026], lines 24-27.)

Headings and Buehl, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) – (3) as above under the §102(e) rejection; and (4) the distribution channel comprises a satellite uplink facility and the downlink channel comprises a satellite downlink facility, as recited in claim 52.

As discussed above, Headings does not disclose or render obvious elements (1) – (3) as above. Accordingly, a combination of Headings with any other references in rejecting claim 52, which depends on 46, is improper.

Furthermore, Buehl merely discloses a high speed distribution network 25 for transmission to subscribers *downstream* in the network (Buehl, paragraph [0026], lines 18-21.), not a satellite *uplink* facility as recited in the rejected claim.

2. Claims 1-24 and 34:

Headings is discussed above.

Sim discloses method and apparatus for automatically adapting a node in a network. A content provider uploads and/or manages large payload files in the scalable content delivery

network (SCDN) 500 through its content provider client (CPC) 530 (Sim, paragraph [0076], lines 7-9; paragraph [0080], lines 4-6). A content provider uses content management applications running on a Content Provider Client system to upload a content and file metadata onto a Content Management Server (CMS) (Sim, paragraph [0094], lines 1-6).

Headings and Sim, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) receiving metadata associated with a multimedia asset data file provided by at least one of a content provider and a multiple service or systems operator (“MSO”), the multimedia asset data file having a content element with which the metadata is associated and being delivered to end users upon requested, the metadata related to at least accuracy of delivery of the multimedia asset data file; (2) validating the multimedia asset data file and the associated metadata by determining if the multimedia asset data file and the associated metadata comply with business rules provided by the MSO; (3) coordinating delivering the multimedia asset data file and associated metadata to a video-on-demand (“VOD”) server maintained by the MSO, wherein coordinating delivering comprises (3a) tracking distributing the multimedia asset data file from the content provider to the MSO, and (3b) tracking uploading the multimedia asset data file from the MSO to the VOD server; and (4) providing usage reports relating to usage of multimedia asset data files by end users of the MSO.

Headings merely discloses metadata may include such descriptive information like copyright information, titles, authors, and abstracts (Headings, paragraph [0033], lines 5-6) or intelligent media may include license tracking information (Headings, paragraph [0033], lines 12-13), NOT the metadata related to at least accuracy of delivery of the multimedia asset data file. Descriptive information is merely related to the content and license tracking information is merely related to the distribution rights. None of these is related to the accuracy of delivery.

In addition, as discussed above under the §102(e) rejection, Headings merely discloses content suppliers can submit a media asset and associated business rules into a safe and secure platform depository (Headings, paragraph [0012], lines 1-4.), NOT validating the multimedia asset data file and the associated metadata by determining if the multimedia asset data file and the associated metadata comply with business rules provided by the MSO. Headings explicitly states that the Digital Content Services function preferably includes use of a software-based application for creating and storing business rules 104, which govern how a particular media

asset 102 is to be used (Headings, paragraph [0028], lines 1-4.) In other words, the business rules are used only to guide the use of the media asset 102. They are not used to validate the media asset 102.

Furthermore, Sim merely discloses distributing large payload files (Sim, paragraph [0072], lines 1-3; paragraph [0076], lines 7-9; paragraph [0080], lines 4-6), NOT multimedia asset data files. A large payload file may merely include a large video file. It may not include the content elements and the metadata associated with each element.

Moreover, Sim merely discloses the popularity index being provided by the content provider, NOT by the multiple service/system operator (MSO). A content provider is not the same as an MSO. A content provider provides the content, but the content provider does not provide services related to the distribution of the content as the MSO.

In the Office Action, the Examiner contends that the claim does not recite “MSO being different than the content provider.” (Office Action, page 3, lines 13-14.) However, the fact that they have different names in the claim clearly indicates that they are different. Otherwise, if the Examiner’s argument is taken seriously, then virtually every element in every claim in every patent must have the phrase “X being different than Y”. Furthermore, it is the Examiner’s burden to show that MSO and content provider are the same based on the conventional definitions of these terms.

Sim merely discloses uploading the content to a Content Management Server (CMS) (Sim, paragraph [0094], lines 1-6), NOT to a video-on-demand (VOD) server. A CMS merely gives the content provider a vehicle to upload large files (e.g., video) to the distribution centers (Sim, paragraph [0080], lines 4-6). The CMS does not distribute the video on demand, or based in the demand of the viewers. Sim does not disclose or render obvious a VOD server. Furthermore, since Sim does not disclose an MSO and/or a VOD server, Sim does not disclose coordinating delivering that comprises tracking distributing the multimedia asset data file from the content provider to the MSO and tracking uploading the multimedia asset data file from the MSO to the VOD server.

In the Office Action, the Examiner contends that Sim discloses file metadata and when user request content using metadata, only content/missing portion of content associated with selected metadata are delivered, citing paragraphs {0115}, [0121], [0166], [0188], [0207-0213],

and [0238] (Office Action, page 2, paragraph 2). Applicant respectfully disagrees. Sim merely discloses the SCDN nodes' storage volumes may contain some, none, or all of the blocks of the end-user's requested file (Sim, paragraph [0115], lines 12-14). This is related to the capacity of the cache volume and has nothing to do with the delivery or the metadata. Furthermore, Applicant notes that in the Office Action, the Examiner does not offer the argument regarding Sim disclosing the metadata related to at least accuracy of delivery. Instead, the Examiner contends that Headings discloses this aspect (Office Action, page 15, paragraph 11) and uses Sim only for the teachings that tracking distributing the multimedia from one location to another location and tracking uploading the multimedia asset data file from the MSO to the VOD server (Office Action, pages 16-17).

3. Claims 35-37, 44-45, and 49-50:

Headings is discussed above.

Ellis '744 discloses a client-server electronic program guide. Each program guide server stores the program guide data provided by the main facility and provides access to the program guide data to program guide clients implemented on the user television equipment of a number of users associated with each television distribution facility (Ellis '744, paragraph [0007], lines 5-9). The program guide servers may also store user data, such as user preference profiles, parental control settings, record and reminder settings, viewing history, and other suitable data (Ellis '744, paragraph [0007], lines 10-13). A program guide server 25 may record the viewing histories of users (Ellis '744, paragraph [0107], lines 1-3). Program guide systems may track user viewing activities and advertisement usage (Ellis '744, paragraph [0108], lines 9-10).

Headings and Ellis '744, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) – (3) as above under the §102(e) rejection; (4a) receiving a schedule request from a server; (4b) providing a customized or localized master schedule for the MSO to the server, the master schedule having an asset locator; (4c) receiving a metadata locator corresponding to the content from the server; (4d) providing an asset locator to the server in response to the metadata locator, the server retrieving an element of the content from a catcher using the asset locator; and (4e) interacting with the server during transfer of the element of the content from the catcher to the server.

As discussed above, Headings does not disclose or render obvious elements (1) – (3) as above. Accordingly, a combination of Headings with any other references in rejecting claims 35-37, 44-45, and 49-50 is improper.

Furthermore, Ellis '744 merely discloses program guide servers may store user data, such as user preference profiles, parental control settings, record and reminder settings, viewing history, and other suitable data (Ellis '744, paragraph [0007], lines 10-13), or the viewing histories of users (Ellis '744, paragraph [0107], lines 1-3), or track user viewing activities and advertisement usage (Ellis '744, paragraph [0108], lines 9-10), NOT receiving a schedule request, or a customized or localized master schedule for the MSO. The user preference profiles, viewing history, etc. are not related to the schedule request or the master schedule for the MSO. It is noted that receiving a schedule request from a server is recited as part of the coordinating uploading. Since Ellis '744 does not disclose coordinating uploading, none of what Ellis '744 discloses can be used to combine with Headings.

The Examiner contends that Ellis '744 discloses an asset locator such as channel source, time, etc. (Office Action, page 32, lines 1-3.) Applicant respectfully disagrees. An asset locator is used to locate the asset, or the content. Here, the channel source or time can only refer to the channel on the television. It does not identify the location of the asset.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). “When determining the patentability of a claimed invention which combined two known elements, ‘the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.’” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To

defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Headings, Buehl, Sim, and Ellis '744 in any combination.

In the present invention, the cited references do not expressly or implicitly disclose any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Headings, Buehl, Sim, and Ellis '744 is an obvious application of

video-on-demand (VOD) management system, or an explicit analysis on the apparent reason to combine Headings, Buehl, Sim, and Ellis '744 in the manner as claimed.

Therefore, Applicant believes that independent claims 1, 20, 25, 41, and 46 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §102(e) and §103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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